

REMARKS

Claims 1-56 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kawai* (U.S. Pub. 2001/0011355 A1) in view of *Computer Networks* by Larry L. Peterson and Bruce S. Davie. Applicants traverse this rejection on the grounds that the references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness.....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

Claims 1 and 15 include:

Claim 1. A method of modifying a memory in a battery unit of a mobile information handling device comprising:
assigning a predetermined data word to an available address in memory;
receiving data in a non-reprogrammable section of the memory;
modifying a programmable section of the memory if the received data complies with the predetermined data word; and
performing a checksum of registers in the memory, whereby the foregoing is accomplished by:
providing a processor;
interfacing a controller between the processor and the battery wait for checking battery unit presence;

coupling a monitor to the processor to determine the battery unit updating requirements; and
coupling a flash device to the processor for providing an updated battery unit configuration.

Claim 15. A mobile information handling device wherein a memory in a battery unit powering the mobile information handling device is reprogrammed comprising:
a processor;
a computer readable medium coupled to the processor; and
computer code, encoded in the computer readable medium configured to cause the processor to:
assign a predetermined data word to an available address in memory;
receive data in a non-reprogrammable section of the memory;
modify a programmable section of the memory if the received data complies with the predetermined data word; and
perform a checksum of registers in the memory, wherein the information handling device includes:
a monitor coupled to the processor to determine the battery unit updating requirements; and
a flash device coupled to the processor to provide an updated battery unit configuration.

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because neither references teach or even suggest the desirability of the combination. Moreover, the references do not provide any incentive or motivation supporting the desirability of the combination. Specifically, the references fail to suggest or disclose a monitor coupled to the processor to determine the battery unit updating requirements and a flash device coupled to the processor to

provide an updated battery unit configuration.

The MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

The Federal Circuit has, on many occasions, held that was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO "failed to establish a *prima facie* case of obviousness":

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had “reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious.” The court noted that to “prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.” The court further noted that there were three possible sources for such motivation, namely “(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art.” Here, according to the court, the board had relied simply upon “the high level of skill in the art to provide the necessary motivation,” without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: “If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance.”

Therefore, independent claims 1 and 15 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1-28 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

PATENT

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Respectfully submitted,



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